12/22/03 #11

60469-037
OT-4812

Entry not recommended
TVT (1/6/03)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application:	O'Donnell, et al.
Serial No.:	09/921,803
Filed:	08/03/2001
Group Art Unit:	3652
Examiner:	Tran, Thuy Van
For:	ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Action mailed on October 21, 2003.

Applicant respectfully traverses the rejection under 35 U.S.C. §102(b) of claims 6, 7, 16, 17, 21 and 23 based upon *Thomson*. The Examiner's interpretation of *Thomson* is unrealistic. As mentioned in the background of the invention portion of the present application and as described in the *Kuo, et al.* reference, for example (column 1, lines 32-40; column 2-column 3, line 25), it is conventional practice to include a wax additive in a polyurethane that acts as a mold release agent. The use of polyurethane in *Thomson*, absent any indication to the contrary, cannot fairly be interpreted as disclosing a waxless polyurethane. The conventional approach for making articles such as elevator belts have polyurethane coatings includes using polyurethanes with additives such as waxes for mold release agents. Therefore, a reference that does not overtly express the opposite

should be interpreted to be consistent with conventional practices. Accordingly, *Thomson* cannot fairly be interpreted to disclose a waxless polyurethane.

Applicant also respectfully traverses the rejection under 35 U.S.C. §103 of claims 6-8 and 16-23 based upon the combination of *De Angelis* with *Graff* or *Scudder*. There is no motivation for making such a combination. The material in *Graff* is intended to make impact resistant windows for bank teller stations or airplane windows, for example. Such a material would have no use in the arrangement of *De Angelis*. Accordingly, one skilled in the art would not look to the teachings of *Scudder* to decide how to modify the arrangement of *De Angelis* Further, *De Angelis* most likely uses a conventional polyurethane material which includes a wax as an internal mold release agent. Accordingly, there is no discussion within *De Angelis* of any outside mold release agent and *De Angelis* supports Applicant's argument that the use of a waxless polyurethane coating is unique and patentable.

Similarly, there is no motivation for adding the teachings of *Scudder* to *De Angelis*. The liberal application of an oily substance to an already formed polyurethane layer has no use within *De Angelis*, which utilizes extrusion molding (column 3, line 10). Once the cable sheathing 8 in *De Angelis* is extrusion molded, there would be no point to adding a lubricant as taught by *Scudder*. In fact, that would render the *De Angelis* arrangement basically useless as the friction intended to be achieved when using the *De Angelis* arrangement would be defeated. There would be no ability to utilize an oil coated cable in an elevator system as provided by the proposed modification of *De Angelis*.

60469-037
OT-4812

Applicant also respectfully traverses the rejection of claims 18-20 and 22 under 35 U.S.C. based upon *Thomson*. As pointed out above, *Thomson* does not disclose nor in anyway suggest using a waxless polyurethane. There is no motivation or suggestion for modifying *Thomson* to be consistent with Applicant's claimed invention apart from Applicant's disclosure. Hindsight reasoning is not proper when trying to establish a *prima facie* case of obviousness.

Moreover, there is no motivation for modifying *Thomson* to include a rectangular cross section. The specific geometries taught in *Thomson* are to serve specific purposes discussed in that reference. If one were to change those geometries to be consistent with Applicant's claims, the *Thomson* reference would no longer achieve its intended results. Any modification to a reference that defeats its intended purpose is not legally proper and lacks the necessary motivation for establishing a *prima facie* case of obviousness.

None of the claims can be fairly considered to be anticipated or obvious. All claims are allowable.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: _____

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Dated: December 22, 2003

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on December 22, 2003.

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Theresa M. Palmateer

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